

REMARKS

Applicant respectfully requests reconsideration and allowance of the subject application. Claims 21 and 39 are canceled, claims 10, 15, 16, 25, 26, 29, 33 and 34 are amended and new claims 58-92 are added. Claims 1-20, 22-38 and 40-92 are pending in this application.

Claims 10, 15, 16, 25, 26, 29, 33 and 34 have been amended to address minor informalities noted during review. These amendments are not intended to alter the scope of the claims.

35 U.S.C. § 102

Claims 1-7, 9-12, 14, 15, 17, 20-25, 28, 31, 32, 36-38, 40-42 and 46-56 (and apparently claim 39) stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,930,473 to Teng et al. (hereinafter "Teng"). Claims 21 and 39 have been canceled. Applicant respectfully submits that claims 1-7, 9-12, 14, 15, 17, 20, 22-25, 28, 31, 32, 36-38, 40-42 and 46-56 are not anticipated by Teng and requests reconsideration in view of the discussion to follow.

Anticipation is a legal term of art. Applicant notes that in order to provide a valid finding of anticipation, several conditions must be met: (i) the reference must include every element of the claim within the four corners of the reference (see MPEP §2121); (ii) the elements must be set forth as they are recited in the claim (see MPEP §2131, infra); (iii) the teachings of the reference cannot be modified (see MPEP §706.02, stating that "No question of obviousness is present" in conjunction with anticipation); and (iv) the reference must enable the invention as recited in the claim (see MPEP §2121.01). Additionally, (v) these conditions must be simultaneously satisfied.

The §102 rejection of claims 1-7, 9-12, 14, 15, 17, 20, 22-25, 28, 31, 32, 36-38, 40-42 and 46-56 is believed to be in error. Specifically, the PTO and Federal Circuit provide that §102 anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). The corollary of this rule is that the absence from a cited §102 reference of any claimed element negates the

anticipation. *Kloster Speedsteel AB, et al. v. Crucible, Inc., et al.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986).

No §103 rejection has been lodged regarding claims 1-7, 9-12, 14, 15, 17, 20, 22-25, 28, 31, 32, 36-38, 40-42 and 46-56. Accordingly, if Applicant can demonstrate that Teng does not disclose any one claimed element with respect to claims 1-7, 9-12, 14, 15, 17, 20, 22-25, 28, 31, 32, 36-38, 40-42 and 46-56, the §102 rejections must be withdrawn, and a subsequent non-final action made with a different rejection in the event that the Examiner still finds such claims to be not allowable.

Applicant notes the requirements of MPEP §2131, which states that "TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM." This MPEP section further states that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.' *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). 'The identical invention must be shown in as complete detail as is contained in the ... claim.' *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)."

Teng describes a video application server for mediating live video services (Title). Teng discloses "An apparatus and method for use in a network including source clients and viewer clients connected to one or more shared transmission

media. A video server is connected to one of the transmission media and is operative to control the broadcast and storage of multiple live or previously-stored video streams. The control may be provided via remote procedure call (RPC) commands transmitted between the server and the clients. In one embodiment, a video presentation system is provided in which a video stream from a source client

is continuously broadcast to a number of viewer clients. One or more of the viewer clients may be authorized by the source client to broadcast an audio and/or video stream to the other clients receiving the source video stream. In another embodiment, a multicast directory is provided to each of a plurality of viewer clients by transmitting directory information in a packet corresponding to a predetermined multicast address. The multicast directory indicates to a particular viewer client which of a number of video programs are available for broadcast to that client." (Abstract).

In contrast, claim 1 recites "A system comprising: a search server; an encoder; a client computer; wherein the encoder is to provide an indication of a currently available live presentation to the search server; wherein the client computer is to submit a request with search criteria to the search server; wherein the search server is to, determine whether the currently available live presentation from the encoder matches the search criteria, and transmit an identifier of the encoder to the client computer if the currently available live presentation matches the search criteria; and wherein the encoder is to provide the live presentation to the client computer", which is not taught or disclosed by Teng.

Claim 9 recites "A method comprising: sending, to a search server, information identifying a live presentation available via a network at the beginning

of the live presentation; and identifying, to the search server, when the live presentation is no longer available via the network", which is not taught or disclosed by Teng.

Teng fails to teach or disclose a search server, as recited in claims 1 and 9. In fact, but for the "Field of Search" front page entry, Teng is void of the term "search". In other words, Teng fails to teach or describe any search server, as recited in claims 1 and 9, or any search criteria, as recited in claim 1. As such, Teng cannot possibly enable the recitation regarding the search server of claims 1 and 9.

The Office Action (p. 2) seeks to equate the video server 12 taught by Teng to the search server recited in Applicant's claims on the basis that (p. 2) the video server 12 is able to offer a list of live video programs. The Office Action further states (p. 2) that "Teng et al. teaches that the server performs search functions (column 6, lines 22-36) since the server stores information that the clients request and the server would have to search to retrieve information for the client." The Office Action additionally states (p. 2) that Teng teaches that "the search server is to, determine whether the currently available live presentation from the encoder matches the search criteria (col. 6, lines 22-36)" Applicant finds no such teachings anywhere in Teng.

The allegations in the Office Action are in error; see col. 6, line 22 et seq., stating, inter alia, that "A given stored video program may be played back in accordance with a request from one or more of the clients 14-i connected to the LAN segment 13." No portion of this paragraph makes any mention of searching or of search criteria or of matching search criteria to available programming, as

recited in claim 1; it merely indicates that a client may initiate playback via a request.

At col. 7, line 44 et seq., Teng states that "The server 12 could also provide a directory list of stored of live video programs currently available to viewer clients. The viewer clients could request the list via an RPC command and then select one of more of the available video programs for viewing and/or storage." Teng also states (line 51 et seq.) that "A directory list could also be provided by transmitting directory information on a single predetermined multicast address." Teng further states (col. 13, line 63 et seq.) that, in one embodiment, "A multicast directory is provided by a server reserving a predetermined multicast address for transmission of directory information."

Teng teaches (col. 14, lines 4-20) that:

A given viewer client receives the directory information by "tuning" to the predetermined multicast address in a conventional manner. The viewer client can utilize the directory information to compile and display a directory list of the currently available directory programs.

The transmitted directory information is updated by the server or the viewer client as programs are added or dropped from the current group of available programs. The viewer client may update the directory list by dropping any listed programs for which the expected identification information has not been received within a predetermined time, and adding any unlisted programs for which identification information has been received. Viewer clients can select an available program or programs from a displayed directory list, and the corresponding video programs are then delivered to the viewer clients at the direction of the server in the manner previously described.

Thus, Teng provides several examples whereby a client may determine available material and request a stored presentation without the video server 12 executing any search function (and without describing any search function).

No example is provided anywhere in Teng that supports the allegations made in the Office Action to the effect that Teng includes any search capability. No effort is shown anywhere in the Office Action to attempt to identify such teachings in Teng.

The Office Action states (p. 3) that "Teng et al. also teaches the use of search criteria (stream attributes) since the client sends a request that would cause the server to play back the information (column 8, lines 55-62 and column 11, lines 4-17). Employing the search criteria is therefore inherent." Such is in error on multiple grounds.

First, stream attributes have nothing to do with search criteria. In fact, Teng teaches (col. 8, lines 57-62) that "The stream attributes describe addressing, buffering, and connectivity characteristics of a stream. Stream attributes include: formats, identifications, source or destination, priority, maximum bandwidth, track statistics, (e.g., size, number of disc array accesses, etc.)." This description has no relationship at all to search criteria as mistakenly alleged, and no discussion to even attempt to establish such a relationship is found in the Office Action.

Second, and as noted above, Teng teaches numerous playback scenarios that do not involve use of search criteria. As such, the allegation that "Employing the search criteria is therefore inherent" is simply and plainly in error. No mention is made anywhere in Teng of search criteria, and the Office Action provides no identification of any such teaching in Teng.

In order to assist in interpretation of what Teng does teach, in terms of readily-understood and comprehended everyday experience, an analogy might be made between the directory list of Teng and a menu at a restaurant or a catalog

from a merchandiser. Such a menu or catalog is a prepared list of potentially available options, which list does not in any way imply searching. The list is prepared prior to review by any potential client or customer and thus cannot employ search criteria.

Further, Teng explicitly teaches that the viewer client updates the directory list and does not teach that the video server 12 updates the list. An analogous situation might be the restaurant patron who knows from prior enquiry that a given item listed on the menu is not presently available, and that a chef's special not described or listed on the menu is presently available, without requiring any search whatsoever.

Third, Applicant notes that inherency is a doctrine relating to results or characteristics and that such is inapposite with respect to positively recited elements. This is discussed in MPEP §2112, entitled "Requirements of Rejection Based on Inherency; Burden".

In a subsection entitled "EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE TENDING TO SHOW INHERENCY", this MPEP section states that "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)(reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

This MPEP subsection further states that "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to

reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)." Accordingly, substitution or addition of claimed elements as allegedly being "inherent" is inappropriate in attempting to make a finding of anticipation.

The Examiner has not provided any authority for the position that claimed elements may be inferred via "inherency" in making an anticipation rejection. The Examiner should either provide authority (e.g., a statute or a citation from 37 CFR or the MPEP or case law) for the position adopted by the Examiner or should withdraw the "inherency" argument.

In other words, the video server 12 as described by Teng includes no search capabilities. The Office Action fails to identify any such teaching or disclosure in Teng.

Claim 9 recites "A method comprising: sending, to a search server, information identifying a live presentation available via a network at the beginning of the live presentation; and identifying, to the search server, when the live presentation is no longer available via the network", which is not taught or disclosed by Teng. Teng is silent with respect to how data describing current live presentations might be obtained or how such information might be kept current.

The portions of Teng cited in the Office Action discuss how one client may authorize or pre-empt another client's input. Terminating one client's input is not equivalent to identifying to a search server when a presentation is no longer available.

The Office Action states (p. 4) that col. 4, lines 12-29 and col. 12, lines 44-50 provide the subject matter recited in claim 9. The former passage is cited for the proposition that Teng teaches "sending, to a search server, information identifying a live presentation available via a network at the beginning of the live presentation".

That passage refers to authorization, by a source client, of a transmission by a viewer client, while the source client is providing a presentation. Such can only occur during a presentation and does not and cannot occur at the beginning of the live presentation, as affirmatively recited in claim 9. Further, Teng teaches that this embodiment concerns (lines 12-15) a continuous presentation, which by definition does not have beginning (or an end).

Additionally, this passage is not concerned with a live presentation. In fact, this passage is void of the word "live". Importing teachings from other embodiments into a specific embodiment comprises impermissible modification of the teachings of a reference (see item (iii) in "Anticipation is a legal term of art", supra) and thus is inappropriate in attempting to establish a *prima facie* case of anticipation.

The Office Action cites the latter passage for the proposition that Teng teaches "identifying, to the search server, when the live presentation is no longer available via the network", as recited in claim 9. That passage fails to teach or describe termination of any live presentation.

The latter passage (col. 12, lines 44-50) states that: "If the presenter decides to allow a given viewer client 215-*i* to broadcast an audio stream, the presenter will enter a command at a terminal of presenter client 210. The command will direct

server to cease broadcasting of the audio stream from presenter client 210 and to commence broadcasting of the audio stream from the designated viewer client 215-i." Teng continues on (lines 50-54) to affirmatively state that "In this case, a suitable indication may be placed in the broadcast audio stream and utilized to notify the viewing clients that the audio stream and video stream are not coming from the same source and therefore need not be strictly synchronized." As such, the video stream is not interrupted and is not terminated. Interruption of the audio stream portion of a video presentation (col. 12, line 7) does not comprise identifying when a live presentation is no longer available, as recited in claim 9.

Provision of resumption of transmission of the audio stream from the presenter is described at col. 12, lines 57-61. As such, this passage cannot possibly be construed as describing "identifying, to the search server, when the live presentation is no longer available via the network", as recited in claim 9. Accordingly, the anticipation rejection of claim 9 is defective and should be withdrawn, and claim 9 should be allowed.

The Office Action cites (p. 3) col. 12, lines 44-50 as providing the subject matter recited in claim 2. As noted with respect to claim 9, Teng fails to teach or disclose provision of any "subsequent indication to the search server indicating that the live presentation is finished", as recited in claim 2, and is silent with respect to any encoder that is further to provide such, as also recited in claim 2. Accordingly, Teng does not and cannot anticipate the invention as recited in claim 2.

With respect to claims 3 and 4, the Office Action indicates (p. 3) that Teng teaches that the encoder provides information identifying current characteristics of

the live performance and cites col. 13, lines 1-13. These text portions describe an interface whereby a presenter can identify viewers and messages that let the users know when they are "ON THE AIR" and when they are not. As such, these text portions provide no information at all regarding information identifying characteristics of a live presentation, as recited in claim 3, or of current characteristics of such, as recited in claim 4. As a result, Teng does not and cannot anticipate the invention as recited in claims 3 and 4.

Claims 5 and 6 each depend from claim 3, which in turn depends from claim 1. As such, claims 5 and 6 incorporates the recitations of these claims by reference (35 U.S.C. §112, 4TH paragraph). The Office Action cites a salmagundi of disparate portions of Teng (viz., col. 6, lines 22-36; col. 7, lines 44-55; col. 11, lines 37-39; col. 4, lines 18-21; col. 11, lines 57-61) in an effort to find the subject matter of claim 1 therein, then leaps to col. 13, lines 1-13 to attempt to arrive at the subject matter of claim 3 and finally attempts to combine passages appearing at col. 8, lines 59-62 and/or col. 12, lines 44-67 to try to arrive at the subject matter of claims 5 and 6. Such a "mix and match" approach to elements each associated with the different various embodiments described by Teng constitutes modification of the teachings of Teng that is impermissible in attempting to find anticipation (see "Anticipation is a legal term of art", items (i) through (iii), supra).

In contrast, 35 U.S.C. §102 deals with evidentiary rules for determining what is identically disclosed in the public domain (see "Anticipation is a legal term of art", sections (i) - (v), supra). It is therefore inappropriate to "mix and match" elements from one embodiment or descriptive portion of Teng with elements from

another embodiment in attempting to make a valid rejection of claimed subject matter under 35 U.S.C. §102.

To assist in identifying what Teng does disclose and the various implementations described therein, Applicant notes that Teng describes "Server Mediation of Live and Stored Video Services" (section I, col. 5, line 28 et seq.) in the context of an exemplary communication network (Fig. 1 and associated text). Within this context, Teng provides a "Video Server Description" (section II, col. 8, line 11 et seq.; Figs. 2, 3A and 3B and associated text). Teng then provides a "Client Description" (section III, col. 9, line 65 et seq.; Figs. 4, 5A and 5B and associated text; note that Figs. 5A and 5B describe different embodiments - see col. 10, line 65). Teng further describes a "Server-Mediated Video Presentation System" (section IV, col. 11, line 18 et seq.; Fig. 6 and associated text). Teng additionally provides description of first embodiments in a portion titled "Multicast Directory Services" (section V, col. 13, line 43 et seq.; other embodiments are described at col. 14, line 21 et seq., beginning with "Alternatively").

The rejection of claims 5 and 6 is *prima facie* defective because such does not conform to the evidentiary rules employed in patent practice for determining what is identically disclosed in the public domain.

Additionally, and in contrast to the discussion in the Office Action (p. 3), claim 5 recites that "the information identifying current characteristics comprises a topic description; and the encoder provides a characteristics finished indication to the search server when the topic identified by the topic description is no longer being presented", while claim 6 recites that "the information identifying the

current characteristics comprises text corresponding to the live presentation", which aspects are not taught or disclosed by Teng.

The Office Action indicates (p. 3) that the recitation in claim 5 that "information identifying current characteristics comprises a topic description" is disclosed at col. 8, lines 59-62. The cited passage states that "Stream attributes include: formats, identifications, source or destination, priority, maximum bandwidth, track statistics, (e.g., size, number of disc array accesses, etc.)." This passage makes no mention whatsoever of any topic description. The Office Action further indicates (p. 3) that the recitation in claim 5 that "the encoder provides a characteristics finished indication to the search server when the topic identified by the topic description is no longer being presented" is "inherent" and is disclosed at col. 12, lines 44-67.

Appropriate legal standards regarding inherency are provided *supra* with reference to MPEP §2112. A simple conclusory statement, such as that on p. 3 of the Office Action, that the affirmatively-recited and claimed elements of claim 5 are "inherent" fails to meet the Examiner's burden of providing a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. Further, the positively recited acts of claim 5 are not characteristics or results; as such the doctrine of inherency is not applicable.

Additionally, the text appearing at col. 12, lines 44-67 fails to provide any indication whatsoever of any "indication to the search server when the topic identified by the topic description is not longer being presented", as affirmatively

recited in claim 5. To clarify what this passage does or does not describe, the passage is reproduced below:

If the presenter decides to allow a given viewer client 215-*i* to broadcast an audio stream, the presenter will enter a command at a terminal of presenter client 210. The command will direct server to cease broadcasting of the audio stream from presenter client 210 and to commence broadcasting of the audio stream from the designated viewer client 215-*i*. In this case, a suitable indication may be placed in the broadcast audio stream and utilized to notify the viewing clients that the audio stream and video stream are not coming from the same source and therefore need not be strictly synchronized. In applications dealing with interactive audio conversation, the amount of audio signal delay between sender and receiver clients is preferably minimized.

If the presenter subsequently decides to terminate the broadcasting privilege of the designated viewer client, the presenter will enter another command and server 205 will process the command such that the audio stream from present client 210 is broadcast in place of the audio stream from the previously designated viewer client. When either the presenter client or a given viewer client is no longer broadcasting its own audio stream, server 205 configures the system such that the presenter client or the given viewer client receives the currently broadcast audio stream from another client.

This passage fails to make any mention at all of any topic description, or of any topic identified by any topic description, or of any indication of when such topic is not being presented, or of any indication of any sort to any search server. In fact, the passage is non sequitur to the subject matter recited in claim 5.

The Office Action cites col. 8, lines 59-62 for the proposition that Teng describes "the information identifying the current characteristics comprises text corresponding to the live presentation", as recited in claim 6. That passage states that "Stream attributes include: formats, identifications, source or destination, priority, maximum bandwidth, track statistics (e.g., size, number of disk array accesses, etc.)." The passage makes no mention of any "text". In fact, the passage is void of the word "text".

The entire passage (col. 8, lines 40-62) is unrelated to provision of information to a search server from an encoder describing a current live broadcast, as recited in claims 6, 3 and 1. The passage instead describes (line 40) software executed in the server 12. The cited portion addresses functions of the stream controller 63, stating that "The stream controller 63 is also responsible for modifying the values of stream attributes in response to Remote Procedure Calls received from a client." The cited portion merely lists what some of these attributes might be.

As such, (i) the rejection of claims 5 and 6 fails to conform to multiple appropriate legal standards as clearly set forth in the MPEP, (ii) fails to provide the elements recited in claims 5 or 6 and (iii) improperly mischaracterizes the disclosure of the reference.

The Office Action relies (pp. 4 and 5) on col. 8, lines 57-62 for anticipation of the subject matter recited in claims 10-12, 14, 15 and 17, stating that "size and track statistics will indicate to the server for a duration of the live presentation", "sending, to the search server, an identifier of an encoder (source) from which the live presentation can be obtained" and the like. The cited passage clearly deals with stored video streams, inasmuch as it defines "track statistics" as including "number of disc array accesses, etc." (see line 62). As such, this passage is completely unrelated to live presentations and is non sequitur to the subject matter of any of these claims.

Further, Applicant finds no teaching of duration of any live presentation in this passage. In fact, Teng uses the word "duration" exactly once (col. 2, lines 64-66), indicating that the amount of data corresponding to a video segment of useful

duration is large. As such, Teng fails to provide any teaching of an indication of duration of the live presentation as recited in claim 10, of identifying an indication of when a live presentation has ended as recited in claim 11, of identifying characteristics of a part of a current live presentation as recited in claim 14, of sending an indication of a duration of the characteristics to the search server as recited in claim 15 or of generating the information identifying the live presentation as the live presentation is presented via the network, as recited in claim 17.

For at least these reasons, the anticipation rejection of claims 1-7, 9-12, 14, 15, 17 is defective and should be withdrawn, and claims 1-7, 9-12, 14, 15, 17 should be allowed.

Claim 22 recites "A method comprising: receiving information identifying a live presentation; and making the information available for searching only for a duration of the live presentation", which is not taught, disclosed, suggested or motivated by the cited reference. The Office Action dated Dec. 20, 2002 notes that Teng fails to teach receiving information identifying a live presentation. As such, the Examiner has admitted, on the record, that Teng does not anticipate the subject matter recited in claim 22. As noted above, Teng also fails to provide any teachings at all relative to duration of a live presentation, as recited in claim 22.

The Office Action indicates (p. 5) that various bits and pieces of the subject matter recited in claim 22 are found in such diverse locations as col. 4, lines 18-21; col. 8, lines 36-38; and col. 11, lines 4-6 and 15-17. Anticipation does not involve use of disparate teachings of a reference as a "parts box" (see items (i) and (ii) in discussion of "Anticipation is a legal term of art", supra). As noted above,

35 U.S.C. §102 deals with evidentiary rules for determining what is identically disclosed in the public domain (see "Anticipation is a legal term of art", sections (i) - (v), *supra*).

Selecting portions of one embodiment and combining these portions with portions of other embodiments constitutes modification of the teachings of the reference, which is impermissible in attempting to fashion a *prima facie* case of anticipation (see item (iii), *supra*). Further, because there is no guidance in the reference to select and then combine various teachings from different and disparate portions of Teng, Teng cannot possibly enable the subject matter recited in claim 22 (see requirement (iv), *supra*). The Office Action fails to provide any of the legal requirements needed in order to find anticipation. As such, the anticipation rejection of claim 22 is *prima facie* defective and should be withdrawn, and claim 22 should be allowed.

Claim 40 recites "One or more computer-readable media having stored thereon a computer program that, when executed by one or more processors, causes the one or more processors to perform functions including: identifying topic information corresponding to live content, the topic information identifying a current topic of the live content; and transmitting the topic information to a server to make the topic information available for searching", which is not taught or disclosed by Teng.

Claim 42 recites "One or more computer-readable media having stored thereon a computer program that, when executed by one or more processors, causes the one or more processors to perform functions including: identifying topic information corresponding to live content, the topic information identifying a

current topic of the live content; and transmitting the topic information to a server to make the topic information available for searching, wherein the transmitting comprises transmitting the topic information to an encoder", which is not taught or disclosed by Teng. The Office Action states (pp. 7, 8) that various positively-recited elements of claims 40 and 42 are "inherent" and cites col. 6, lines 22-24.

Col. 6, lines 22-24 states that: "A given stored video program may be played back in accordance with a request from one or more of the clients 14-i connected to the LAN segment 13." This passage is devoid of any description of identifying live content and in fact is unrelated to live content, because it describes playback of stored video content. As such, this passage is inherently incapable of describing or teaching anything relative to "identifying topic information corresponding to live content, the topic information identifying a current topic of the live content", as recited in claims 40 and 42.

The Office Action cites col. 11, lines 4-6 for transmitting topic information to a server to make such available for searching, as recited in claim 42, and cites lines 4-17 for transmitting the topic information to a server to make the topic information available for searching, as recited in claim 40.

As noted above, Teng fails to teach or disclose anything relative to searching, and provides examples of system operation that obviate need for searching. In fact, the description contained in col. 11, lines 4-6 describes "software executed by the CPU 91 in the client 14-1 of Fig. 4" (col. 10, line 20 et seq.) and as such is completely unrelated to transmission of topic information to a server, making topic information available for searching, or transmitting information to an encoder.

Claim 46 recites "An apparatus comprising: a bus; a processor coupled to the bus; and a memory, coupled to the bus, to store a plurality of instructions that are executed by the processor, wherein the plurality of instructions, when executed, cause the processor to, receive information identifying live content, maintain the information for as long as the live content is available, and use the information to respond to searches from a plurality of client computers", which is not taught or disclosed by Teng. As noted above, Teng fails to provide any teaching or disclosure of searches or searching.

The Office Action cites col. 6, lines 10-21 for the proposition that Teng teaches instructions, that, when executed, cause the processor to receive information identifying live content, as recited in claim 46. Col. 6, lines 7-21, states that:

The server 12 can also direct storage of video streams from one or more of the clients 14-i and subsequently play the stored files back in accordance with video-on-demand selections of the clients. For example, a particular live video program supplied by the video camera 15 via client 14-1 may be stored at the direction of server 12 in a storage device 17 connected to client 14-3. The storage device 17 may be a magnetic disc array or tape, a recordable optical disc or an electronic memory. The server 12 may also direct storage of live or previously-recorded video to a mass digital storage device directly connected to the server itself. Such a mass digital storage device in the form of a disk array 54 is shown in Fig. 2 below. Additional details regarding video storage can be found in the above-cited U.S. patent applications Ser. Nos. 07/977,493 and 08/254,576.

This passage provides no teachings at all regarding information identifying live content. It describes storage of video streams from a variety of sources. Similarly, the passage at col. 6, lines 30-36 describes viewing or storage of video data and is silent with respect to information identifying live content.

Further, various portions of claims 40, 42 and 46 are stated to be "inherent" (pp. 7, 8). As noted above, such fails to meet the Examiner's burden of providing a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. Further, the positively recited acts or elements of claims 40, 42 and 46 are not characteristics or results; as such the doctrine of inherency is not applicable. The rejection of claims 40, 42 and 46 fails to meet any of the legal requirements for finding anticipation (see "Anticipation is a legal term of art", supra).

Claim 53 recites "An apparatus comprising: a bus; a processor coupled to the bus; and a memory, coupled to the bus, to store a plurality of instructions that are executed by the processor, wherein the plurality of instructions, when executed, cause the processor to, receive information identifying live content, maintain the information for as long as the live content is available, and use the information to respond to searches from a plurality of client computers, wherein the plurality of instructions, when executed, further cause the processor to: receive information identifying current topic information identifying a topic currently being presented as part of the live content; receive an indication that the topic is no longer being presented; maintaining the topic information for a period of time after receiving the indication that the topic is no longer being presented; and using the current topic information to respond to searches from the plurality of computers during the period of time", while claim 54 recites "An apparatus comprising: a bus; a processor coupled to the bus; and a memory, coupled to the bus, to store a plurality of instructions that are executed by the processor, wherein the plurality of

instructions, when executed, cause the processor to, receive information identifying live content, maintain the information for as long as the live content is available, and use the information to respond to searches from a plurality of client computers, wherein the plurality of instructions, when executed, further cause the processor to generate, based on the information identifying live content, descriptive information to be added to a database of live content", which is not taught or disclosed by Teng.

The Office Action cites (pp. 10, 11) col. 6, lines 15-19 and col. 7, lines 9 and 10 for the proposition that Teng teaches a "plurality of instructions" that "when executed, cause the processor to, receive information identifying live content", as recited in claims 53 and 54. Col. 6, lines 15-19 states that: "The server 12 may also direct storage of live or previously-recorded video to a mass digital storage device directly connected to the server itself. Such a digital mass storage device in the form of a disk array 54 is shown in Fig. 2. below." This describes storage of video information in a mass digital storage device; it does not teach or disclose any "instructions" that "when executed, cause the processor to receive information" of any sort, and does not teach or disclose anything relative to information identifying live content. Live content in and of itself does not necessarily provide information describing the live content.

Col. 7, lines 9 and 10 states that "The sever 12 can direct distribution of live of stored video to and from clients 42-*i* via PSTN 36 and hub switch 30." Again, this passage fails to teach or disclose any instructions of any sort, or instructions that cause a processor to receive information, or anything relative to information

identifying live content. In fact, both passages are void of any term such as "instructions" or "identifying".

Claim 55 recites "A method comprising: identifying a set of search criteria to be compared to information describing a plurality of live presentations; transmitting the set of search criteria to a server; and receiving a list of live presentations currently in progress that match the search criteria", which is not taught or disclosed by Teng.

The Office Action cites col. 7, lines 44-55 as teaching the subject matter recited in claim 55. The cited passage is reproduced below:

The server 12 could also provide a directory list of stored or live video programs currently available to viewer clients. The viewer clients could request the list via an RPC command and then select one or more of the available video programs for viewing and/or storage. The server 12 would then respond by directing the appropriate video streams from one or more source clients or the server itself in accordance with the viewer client selections. A directory list could also be provided by transmitting directory information on a single predetermined multicast address. These and other directory services will be described in further detail below.

This passage fails to teach or describe anything relating to search criteria, or identification of search criteria, or transmission of search criteria to a server, or receiving a list of presentations, live or otherwise, having any relationship to search criteria. This passage simply describes provision of "a directory list of stored or live video programs currently available to viewer clients", without any reference to search criteria.

For at least these reasons, Applicant respectfully requests that the §102 rejections be withdrawn, and that claims 1-7, 9-12, 14, 15, 17, 20-25, 28, 31, 32, 36-42 and 46-56 should be allowed.

35 U.S.C. § 103

Claims 8, 13, 16, 18, 19, 26, 27, 29, 30, 33-35, 43-45 and 57 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Teng. Applicant respectfully submits that claims 8, 13, 16, 18, 19, 26, 27, 29, 30, 33-35, 43-45 and 57 are not unpatentable over Teng and requests reconsideration in view of the discussion to follow.

Claim 8 recites "A system comprising: a search server; an encoder configured to provide an indication of a currently available live presentation to the search server; a client computer configured to submit a request with search criteria to the search server, the search server being configured to determine whether the currently available live presentation from the encoder matches the search criteria, and transmit an identifier of the encoder to the client computer when the currently available live presentation matches the search criteria; wherein the encoder is configured to provide the live presentation to the client computer, and wherein the search server is further configured to: maintain a record of user search requests; and notify the corresponding user when a new live presentation becomes available that satisfies a search request", which is not taught, disclosed, suggested or motivated by Teng.

The Office Action states (pp. 11, 12) that Teng teaches a system comprising a search server, noting that such is found as "(server 12, this is a search server since the client computer requests the list of live video programs, column 6, lines 22-36 and column 7, lines 44-55)" As noted above, the video server 12 disclosed by Teng is not a search server; Teng makes no representation that the video server 12 is a search server; and the Office Actions fail to identify any

evidence in Teng to support characterizing the video server 12 taught by Teng as a "search server". As also noted above (see "35 U.S.C. §102"), Teng describes a number of scenarios for provision of a directory list or information allowing the client to assemble such a list that do not involve searching.

As further noted above (see "35 U.S.C. §102"), a reasonable analogy might be made between the directory list of Teng and a menu at a restaurant or a catalog from a merchandiser. Such a menu or catalog is a prepared list of potentially available options, which list does not in any way imply searching. Further, Teng explicitly teaches embodiments (col. 13, line 63 through col. 14, line 8; col. 14, lines 25-34) in which the viewer client updates the directory list and does not teach that the video server 12 updates the list. An analogous situation might be the restaurant patron who knows from prior enquiry that a given item listed on the menu is not presently available, and that a chef's special not described or listed on the menu is presently available, without requiring any search whatsoever.

The Office Action states (p. 12) that Teng teaches a system "wherein the client computer is to submit a request with search criteria" and attempts to equate such to a "client requesting a list", citing col. 7, lines 44-48. The discussion contained therein also is usefully analogized to a patron requesting a menu from waitstaff at a restaurant - such in no way implies submission of search criteria, rather, it is a request for a previously prepared list of potentially available options, which list does not in any way imply searching or search criteria.

Inasmuch as both the directory list of Teng and the menu are prepared prior to the request, neither can possibly include or specifically respond to any information ("search criteria") specifically identified in the request. As such, a

request for such a list does not and cannot teach, disclose, suggest or motivate any request submitted with search criteria to a search server, as described in the subject matter of claim 8.

The Office Action states (p. 12) that Teng teaches a system wherein "the search server is to, determine whether the currently available live presentation from the encoder matches the search criteria (column 6, lines 22-36)". This passage merely states that "A given stored video program may be played back" Stored programming is not live programming. This passage further states that "The server 12 may retrieve stored video from a CD-ROM drive" Again, stored programming is not live programming. This passage further states that "A particular live video program being viewed by a particular client 14-i may be recorded" but is silent regarding any selection by a user, search by the video server 12 (or anything else) or determination of whether currently available live presentation matches search criteria.

The Office Action states (p. 12) that Teng teaches that the search server is to "transmit an identifier (directory list) of the encoder to the client computer if the currently available live presentation matches the search criteria (column 7, lines 44-55)". Teng teaches transmission of such a list upon issuance of an RPC command, and is silent regarding any match to search criteria. Transmission of such a list, as taught by Teng, is not contingent on any match to anything.

Accordingly, the unpatentability rejection of claim 8 fails to meet the requirements of §2143 or §706.02(j) (set forth infra) for establishing a *prima facie* case of unpatentability. In part, this is because numerous affirmatively-recited elements of the claim are not found in the reference.

The Office Action correctly further states (p. 12) that "Teng et al. does not teach maintaining a record of user search requests; and notifying the corresponding user when a new live presentation becomes available that satisfies a search request" The Office Action then states (and also repeatedly states with respect to other claims) that "[o]fficial notice is taken on this limitation. It would have been obvious"

With respect to all such allegations, as there is no basis for the Examiner's contentions within the cited reference, the only possible motivation for these contentions is hindsight reconstruction wherein the Examiner is utilizing Applicant's own disclosure to construct a reason for modifying the cited reference. The Examiner is reminded that hindsight reconstruction is not an appropriate basis for a §103 rejection. (*See, e.g., Interconnect Planning Corp. v. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985); *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990) (explaining that hindsight reconstruction is an improper basis for rejection of a claim).) Such an ad hoc conclusion also fails to provide evidence of motivation or suggestion to modify (see *In re Dembiczaik*, infra).

Since the statement is not supported by the reference, it must be made on the basis of personal knowledge of the Examiner's. Applicant notes the requirements of MPEP §1.104, entitled "Nature of examination", which states that "When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons." In the event that

the Examiner persists with this basis for any unpatentability rejection, Applicant calls for such an affidavit or other objective evidence to support this position with respect to each such allegation in the event that such rejection is maintained.

Further, the strained interpretation provided by the Examiner gives each of the terms "search", "search server" and/or "search criteria" a meaning repugnant to the ordinary meaning of that term. This is discussed in more detail in MPEP §2111.01, entitled "Plain Meaning". This MPEP section states that "THE WORDS OF A CLAIM MUST BE GIVEN THEIR "PLAIN MEANING" UNLESS THEY ARE DEFINED IN THE SPECIFICATION". This MPEP section further states that "While the meaning of claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims must be interpreted as broadly as their terms reasonably allow. This means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)". The interpretation relied on by the Examiner clearly gives these terms meanings repugnant to the ordinary meaning of the terms.

The reference does not provide numerous affirmatively-recited aspects of the claimed subject matter. The Office Action, in misinterpreting the disclosure of the reference, provides numerous statements that clearly mischaracterize the disclosure of the reference to attempt to find the claimed subject matter within the four corners of the reference. Such is clearly improper in interpretation of a reference.

Further, there is no basis for the Examiner's contentions within the cited reference. No motivation is identified in the reference for the proposed modification and additions to the disclosure of the reference. Moreover, no evidence to motivate modification of the reference is identified. Against this backdrop, the rejection clearly employs an improper 'obvious to try' standard for finding unpatentability (discussed infra).

Additionally, the Office Action, in stating that Teng fails to teach or disclose affirmatively-recited aspects of the subject matter of claim 8, admits, on the record, that the rejection fails to conform to the requirements set forth in MPEP §2143 or §706.02(j) for establishing a prima facie case of unpatentability.

Accordingly, the rejection of claim 8 (i) fails to meet the criteria set forth for a prima facie finding of unpatentability, by (i)(a) failing to provide elements from the claim and by (i)(b) failing to identify motivation in the reference, (ii) being based on impermissible hindsight reconstruction, (iii) failing to identify evidence of motivation to modify, (iv) giving the term "search" a meaning repugnant to the ordinary meaning of the term, (v) mischaracterizing the disclosure of the reference, (vi) employing an improper 'obvious to try" standard for postulating unpatentability, (vii) contravening the Examiner's prior admissions on the record as to the deficiencies of the reference and (viii) providing further evidence in the rejection that the reference does not provide the affirmatively-recited subject matter of the claim, as required to form a prima facie case of unpatentability.

Claim 13 recites that "sending the identifier comprises sending, as the identifier, a uniform resource locator (URL)", which is not taught, disclosed,

suggested or motivated by the cited reference. The identifier is associated with the encoder from which the live presentation can be obtained.

Claim 13 depends from claim 12, which, in turn depends from claim 9. As such, claim 13 incorporates the recitations of these claims by reference (35 U.S.C. §112, 4TH paragraph).

As noted above, Teng fails to provide any teaching of identifying to a search server when a live presentation is no longer available, as recited in claim 9. Teng is also silent with respect to providing a URL as an identifier for a client. In fact, Teng is completely void of any reference to the Internet and to uniform resource locators. Further, the Office Action dated December 2002 (p. 6), affirmatively states that Teng fails to provide any teaching, disclosure, suggestion or motivation for supplying a URL as an identifier of an encoder from which a live presentation is available. As such, the rejection of claim 13 fails to meet the criteria provided in MPEP §2143 or §706.02(j) for establishing a prima facie case of unpatentability. Accordingly, the rejection of claim 13 is defective and should be withdrawn, and claim 13 should be allowed.

Claim 16 recites "A method comprising: sending, to a search server, information identifying a live presentation available via a network at the beginning of the live presentation; and identifying, to the search server, when the live presentation is no longer available via the network, further comprising: identifying, to the search server, information indicating characteristics of a part of the live presentation currently being presented, wherein the identifying information includes sending, to the search server, an indication of a duration of the characteristics, and wherein the identifying information comprises: sending, to

the search server, an indication of the characteristics when the current characteristics begin to describe the live presentation; and sending, to the search server, a characteristics finished indication when the current characteristics no longer describe the live presentation", which is not taught, disclosed, suggested or motivated by Teng.

As noted above, Teng is silent with respect to any search server. Teng is also silent with respect to information indicating characteristics of a part of a live presentation currently being presented, or sending such information to a search server. In addition to previously-discussed citations (e.g., col. 6, lines 22-30-36, discussed above with reference to claim 8), the Office Action cites col. 6, lines 62-65 as disclosing "sending, to a search server, information identifying a live presentation available via a network at the beginning of the live presentation". The cited passage states that "For example, a live video program from a video camera 33 attached to client 32-i may be broadcast under the control of server 12 and viewed by client 32-2 on a display 34." This passage is completely devoid of any reference whatsoever to "sending, to a search server, information identifying a live presentation available via a network at the beginning of the live presentation", as affirmatively recited in claim 16.

The Office Action further states (pp. 12 and 13) that Teng teaches "identifying, to the search server, when the live presentation is no longer available via the network (inherent since it is a live presentation)". As noted above with respect to the rejections under 35 U.S.C. §102 (and referring again to MPEP §2112, *supra*), inherency is a doctrine relating to results or characteristics and does not support substitution or addition of claimed elements as allegedly being

"inherent". In other words, inherency doctrine is inappropriate in attempting to make a finding of unpatentability when the reference fails to disclose affirmatively-recited elements of the claim.

Claim 18 recites "A method comprising: sending, to a search server, information identifying a live presentation available via a network at the beginning of the live presentation; and identifying, to the search server, when the live presentation is no longer available via the network, further comprising generating the information identifying the live presentation as the live presentation is presented via the network, wherein the generating comprises identifying key words as the live presentation is presented", which is not taught, disclosed, suggested or motivated by Teng.

Claim 19 recites "A method comprising: sending, to a search server, information identifying a live presentation available via a network at the beginning of the live presentation; and identifying, to the search server, when the live presentation is no longer available via the network, further comprising using closed captioning data as the information identifying the live presentation", which is not taught, disclosed, suggested or motivated by Teng.

The Office Action states (p. 13) that "In considering claims 18 and 19, Teng et al. teaches sending, to a search server, information identifying a live presentation" and cites col. 6, lines 30-36 and 62-65. The Office Action further states that Teng teaches "identifying, to the search server, when the live presentation is no longer available via the network (inherent)". These passages have been analyzed above and these arguments have been repeatedly rebutted above.

Further, Teng provides objective evidence that such is not inherent. Teng teaches (col. 14, lines 11-16) that "The viewer client may update the directory list by dropping any listed programs for which the expected identification information has not been received within a predetermined time, and adding any unlisted programs for which identification information has been received."

Teng also teaches (lines 27-34) that "The directory information may be transmitted from the source clients in a predetermined multicast address or other addressable channel location within a given transmitted data stream. Each viewer client can then receive the directory information directly from each source client and independently configure a list of video programs available to that client."

Why would Teng provide such teachings if "identifying, to the search server, when the live presentation is no longer available via the network", as recited in claim 18, were "inherent since it is a live presentation", as alleged in the Office Action? Clarification of the reasoning and the rejection is requested.

The Office Action further states (p. 13) that Teng teaches "generating the information indicating characteristics of a part of the live presentation currently being presented (column 8, lines 40-45 and lines 55-62, the presenter client would have to provide characteristics (stream attributes) to the server)." As noted above with reference to the anticipation rejection of claims 1 and 9, this passage is clearly directed to stored video programming (e.g., stream attributes include: ... disk array accesses", lines 59-62), and thus is unrelated to anything relative to a live presentation, as recited in claim 18.

Teng is silent with respect to "generating the information identifying the live presentation". Teng is also silent with respect to doing so "as the live

presentation is presented via the network, wherein the generating comprises identifying key words as the live presentation is presented", as recited in claim 18.

The Office Action admits, on the record (p. 14), that "Teng does not teach identifying key words as the live presentation is being presented" (as recited in claim 18) or "using closed captioning data as the information identifying the live presentation", as recited in claim 19. The Office Action states that "official notice is taken" and "It would have been obvious" These arguments have been rebutted above with reference to the unpatentability rejection of claim 8.

Since the statement to the effect that "It would have been obvious" to augment the disclosure of the reference is not supported by the reference, it must be made on the basis of personal knowledge of the Examiner's. Applicant notes the requirements of MPEP §1.104, entitled "Nature of examination", which states that "When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons." In the event that the Examiner persists with this basis for any unpatentability rejection, Applicant calls for such an affidavit or other objective evidence to support this position with respect to each such allegation.

Claim 26 recites "A method comprising: receiving information identifying a live presentation; and making the information available for searching only for a duration of the live presentation, and further comprising: receiving information identifying a plurality of live presentations; for each live presentation, making the

information identifying the live presentation available for searching only for the duration of the live presentation; maintaining a record of user search requests; and notifying the corresponding user when a new live presentation that satisfies a search request is available", which is not taught, disclosed, suggested or motivated by Teng.

The Office Action cites (p. 14) col. 6, lines 62-65 and the inherency doctrine with respect to portions of the subject matter of claim 26. These passages have been analyzed above and these arguments have been repeatedly rebutted above.

The Office Action cites col. 4, lines 12-29 with respect to "receiving information identifying a plurality of live presentations", as recited in claim 26. The Office Action cites inherency as providing "making the information identifying the live presentation available for searching only for the duration of the live presentation", as recited in claim 26. Applicant has rebutted misapplication of the doctrine of inherency above. Further, Applicant notes that the reference fails to support the conclusion expressed in the Office Action, as is discussed below in more detail.

Teng teaches (col. 14, lines 11-16) that "The viewer client may update the directory list by dropping any listed programs for which the expected identification information has not been received within a predetermined time, and adding any unlisted programs for which identification information has been received." Teng also teaches (lines 27-34) that "The directory information may be transmitted from the source clients in a predetermined multicast address or other addressable channel location within a given transmitted data stream. Each viewer

client can then receive the directory information directly from each source client and independently configure a list of video programs available to that client." Why would Teng provide such teachings if "receiving information identifying a plurality of live presentations", as recited in claim 26, were "inherent because this is a live presentation", as alleged in the Office Action? Clarification of the reasoning and the rejection is requested.

The Office Action correctly states (p. 14) that "Teng et al. does not teach maintaining a record of user search requests; and notifying the corresponding user when a new live presentation that satisfies the search request is available", as recited in claim 26. The Office Action indicates that "official notice is taken" and that "It would have been obvious"

With respect to the official notice, Applicant again calls for an affidavit or other evidence to support the conclusions expressed in the Office Action in the event that such rejection is maintained. The conclusion that "It would have been obvious" has been repeatedly rebutted.

Claim 27 recites "A method as recited in claim 26, further comprising: receiving, for each of the user search requests, an indication of how the user should be notified; and notifying the user in accordance with the notification", which is not taught, disclosed, suggested or motivated by Teng. The Office Action states (p. 15) that Teng teaches the receiving and notifying acts recited in claim 27, however, this appears to be a typographical error inasmuch as the Office Action then states that "however, official notice is taken on such a limitation" Clarification is requested.

The Office Action indicates (p. 15) that "official notice is taken" and that "It would have been obvious" With respect to the official notice, Applicant again calls for an affidavit or other evidence to support the conclusions expressed in the Office Action in the event that such rejection is maintained. The conclusion that "It would have been obvious" has been repeatedly rebutted.

Assuming that what was stated in the Office Action was a typographical error, the Office Action provides tacit admission that Teng fails to provide the elements recited in claim 27. As such, the rejection is *prima facie* defective and should be withdrawn, and claim 27 should be allowed.

Claim 29 recites "A method comprising: receiving information identifying a live presentation; and making the information available for searching only for a duration of the live presentation, wherein the making the information available for searching comprises: adding the information to a database of currently available live presentations; and deleting the information from the database when the live presentation has ended", which is not taught, disclosed, suggested or motivated by Teng.

The Office Action cites (p. 15) col. 6, lines 30-36 and 62-65, offers an inherency argument and cites col. 7, lines 9 and 10 as with respect to the receiving and making clauses of claim 29. These passages have been analyzed above and these arguments have been repeatedly rebutted above.

The Office Action also cites (p. 15) col. 6, lines 15-21 and col. 8, lines 20 and 21 with respect to the recitation in claim 29 that "making the information available for searching comprises: adding the information to a database of currently available live presentations". Col. 6, lines 7-21, states that:

The server 12 can also direct storage of video streams from one or more of the clients 14-i and subsequently play the stored files back in accordance with video-on-demand selections of the clients. For example, a particular live video program supplied by the video camera 15 via client 14-1 may be stored at the direction of server 12 in a storage device 17 connected to client 14-3. The storage device 17 may be a magnetic disc array or tape, a recordable optical disc or an electronic memory. The server 12 may also direct storage of live or previously-recorded video to a mass digital storage device directly connected to the server itself. Such a mass digital storage device in the form of a disk array 54 is shown in Fig. 2 below. Additional details regarding video storage can be found in the above-cited U.S. patent applications Ser. Nos. 07/977,493 and 08/254,576.

This passage provides no teachings at all regarding information identifying live content, making the information available for searching or by doing so by adding the information to a database of currently available live presentations. It describes storage of video streams from a variety of sources. Similarly, the passage at col. 8, lines 20 and 21 states that "The server 12 also includes an SCSI-II disc array 54 for multi-access digital video storage". Such is completely unrelated to adding information identifying a live presentation to a database of currently available live presentations to make such available for searching.

To assist in clarifying distinctions between what is recited in Applicants' claims and what is disclosed by Teng, an analogy might distinguish between storing the written contents of a menu (information describing something that may be available) in a database and storing items, such as specific dishes, in a refrigerator, where the stored items or dishes that may be available from the menu may be selected by searching the menu entries in the database using search criteria (e.g., "vegetarian dishes"). Both tasks include an element of organization, however, this superficial commonality does not render them interchangeable.

The Office Action states (p. 15) that "Teng et al. does not teach deleting the information from the database when the live presentation has ended, however,

such a method would have been obvious to one of ordinary skill in the art in order to save disk space for video information that would need to be saved."

However, Teng explicitly teaches storage of video programs (see, e.g., Abstract, col. 1, lines 19-29; col. 3, line 66 through col. 4, line 5; col. 5, lines 50-52; col. 6, lines 7-21, 30-34, col. 7, lines 7-21 and 44-55; col. 8, lines 20 and 21). Teng provides no teaching or disclosure of "deleting the information from the database when the live presentation has ended", as recited in claim 29. Teng is hard put to do so because Teng fails to describe adding information describing a live presentation to a database.

In fact, Teng repeatedly discloses recording of live presentation data for later viewing. This purpose is utterly frustrated by deletion of recorded video information, as suggested in the Office Action.

Claim 30 recites "A method as recited in claim 29, further comprising: receiving a user search request; and accessing the database of currently available live presentations to determine whether a currently available live presentation matches the user search request", which is not taught, disclosed, suggested or motivated by Teng.

The Office Action cites (p. 15) col. 6, lines 22-27 with respect to the subject matter of claim 30. As noted above with reference to the anticipation rejections of claims 1 and 9, Teng is silent with respect to search requests, any database of currently available live presentations, accessing any such database or doing so to determine whether a currently available live presentation matches the user search request.

Claim 33 recites "A method comprising: receiving information identifying a live presentation; making the information available for searching only for a duration of the live presentation; receiving information identifying a current characteristic of the live presentation; and making the current characteristic available for searching for as long as the characteristic describes a currently presenting portion of the live presentation, wherein the making the current characteristic available for searching comprises: adding the information identifying the current characteristic to a database of currently available live presentations; and deleting the information identifying the current characteristic from the database when the characteristic no longer describes the currently presenting portion of the live presentation" while claim 34 recites "A method comprising: receiving information identifying a live presentation; making the information available for searching only for a duration of the live presentation; receiving information identifying a current characteristic of the live presentation; and making the current characteristic available for searching for as long as the characteristic describes a currently presenting portion of the live presentation, and further comprising: maintaining a record of user search requests; and alerting a corresponding user when a new current characteristic that satisfies a search request describes the currently presenting portion of the live presentation", which subject matter is not taught, disclosed, suggested or motivated by Teng.

The Office Action states (p. 15, and again on p. 16 with reference to claim 34) that Teng teaches "receiving information identifying a live presentation", citing col. 6, lines 62-65, and further states that "since the video server is controlling the live video program, it implies that the video server receives the live

video program". However, controlling a program does not necessarily imply "receiving information identifying a live presentation". In fact, the two concepts are unrelated.

There is no teaching or disclosure, or suggestion or motivation, contained anywhere in Teng that would lead one to the notion that a LAN segment 31 coupling clients together, or a video server 12 mediating distribution of live or stored video, has any knowledge whatsoever of information identifying information going to or coming from any of the clients. Similarly, an email routing system has no need for or capability for receiving information identifying contents of an email being transmitted through the system, even though the routing system has control of and mediates distribution of such communications.

The Office Action further states (p. 15, last line, extending to p. 16, and again at p. 16 with reference to claim 34) that "making the information available for searching only for the duration of the live presentation" is "inherent since the presentation is live". As noted above with reference to claims 18 and 19, Teng provides objective evidence rebutting the assertion that such is "inherent". Further, inherency doctrine relates to characteristics or results and is not a carte blanche tool for supplying affirmatively-recited claim elements (see rebuttal of rejection of claims 1 and 9, *supra*).

The Office Action states (p. 16, and again on p. 17 with reference to claim 34) that "receiving information identifying a current characteristic of the live presentation" is "inherent" and also cites col. 8, lines 55-63. As noted above with reference to claims 1 and 9, the passage at col. 8, lines 55-63 describes attributes

for stored video programs and is silent with respect to any live presentation, as recited in claims 33 and 34.

The Office Action further states (p. 16, again on p. 17 with reference to claim 34) that "making the current characteristic available for searching for as long as the characteristic describes a currently presenting portion of the live presentation" is inherent to the teachings of Teng. As noted above, Teng is silent with respect to making any characteristics available. Further, as noted above, Teng provides objective evidence that even currency of a directory list, as taught by Teng, is not "inherent". Clarification of the reasoning and the rejection is requested.

The Office Action states (p. 16), that the recitation in claim 33 that "making the current characteristic available for searching comprises: adding the information identifying the current characteristic to a database of currently available live presentations" is "inherent" and references col. 6, lines 15-21 and col. 8, lines 20 and 21.

As noted above with reference to claim , Teng provides objective evidence rebutting the notion that adding such information to a database is inherent (see (col. 14, lines 11-20, explaining how a client might construct a directory list; rebuttal of rejection of claims 1 and 9; rebuttal of rejection of claims 18 and 19). These passages have been analyzed above and these arguments have been repeatedly rebutted above.

The Office Action correctly states (p. 16) that Teng is silent with respect to the recitation in claim 33 of "deleting the information identifying the current characteristic from the database when the characteristic no longer describes the

currently presenting portion of the live presentation". Such is a tacit admission that the rejection fails to meet the standards set forth in the MPEP (see discussion of §2143 and §706.02(j) below).

The Office Action correctly states (p. 17) that Teng is silent with respect to "maintaining a record of user search requests; and alerting a corresponding user when a new current characteristic that satisfies a search request describes the currently presenting portion of the live presentation", as recited in claim 34. The Office Action indicates that official notice is taken and that "It would have been obvious" These arguments have been discussed above. With respect to the official notice, Applicant again calls for an affidavit or other evidence to support the conclusions expressed in the Office Action in the event that such rejection is maintained. The conclusion that "It would have been obvious" has been repeatedly rebutted.

Claim 35 recites "A method as recited in claim 33, further comprising: receiving a user search request; and checking the database of currently available live presentations to determine, based at least in part on the current characteristic in the database, whether a currently available live presentation matches the user search request", which is not taught, disclosed, suggested or motivated by Teng.

The Office Action states (p. 17) that Teng "teaches receiving a user search request (column 6, lines 22-24); and checking the database of currently available live presentations to determine, based at least in part on the current characteristic in the database, whether a currently available live presentation matches the user search request (column 6, lines 13-17 and lines 27-36)." As noted above, Teng does not teach searching, search requests, checking a database or determination of

when a current program, live or not, matches a search request. The allegations in the Office Action are in error. As previously noted, col. 6, lines 7-21, states that:

The server 12 can also direct storage of video streams from one or more of the clients 14-*i* and subsequently play the stored files back in accordance with video-on-demand selections of the clients. For example, a particular live video program supplied by the video camera 15 via client 14-1 may be stored at the direction of server 12 in a storage device 17 connected to client 14-3. The storage device 17 may be a magnetic disc array or tape, a recordable optical disc or an electronic memory. The server 12 may also direct storage of live or previously-recorded video to a mass digital storage device directly connected to the server itself. Such a mass digital storage device in the form of a disk array 54 is shown in Fig. 2 below. Additional details regarding video storage can be found in the above-cited U.S. patent applications Ser. Nos. 07/977,493 and 08/254,576.

This passage provides no teachings at all regarding a database of currently available live presentations, or of a search request being employed to determine, based at least in part on the current characteristic in the database, whether a currently available live presentation matches the user search request, as described in claim 35. It merely describes storage of video streams from a variety of sources. Similarly, the passage at col. 6, lines 30-36 describes viewing or storage of video data and is silent with respect to information identifying live content.

This passage merely states that "A given stored video program may be played back" Stored programming is not live programming. This passage further states that "The server 12 may retrieve stored video from a CD-ROM drive" Again, stored programming is not live programming. This passage further states that "A particular live video program being viewed by a particular client 14-*i* may be recorded" but is silent regarding any search criteria or a search request being employed to determine, based at least in part on the current characteristic in the database, whether a currently available live presentation matches the user

search request, as described in claim 35; it merely indicates that a client may initiate playback of a stored video program via a request. As such, this passage is unrelated to the subject matter of claim 35.

Claim 43 recites "One or more computer-readable media having stored thereon a computer program that, when executed by one or more processors, causes the one or more processors to perform functions including: identifying topic information corresponding to live content, the topic information identifying a current topic of the live content; and transmitting the topic information to a server to make the topic information available for searching, further comprising transmitting a topic finished indication to the server when the topic information is no longer the current topic", which is not taught, disclosed, suggested or motivated by Teng.

The Office Action states (p. 17) that Teng teaches "computer readable media having stored thereon a computer program, that, when executed by one or more processors, causes the one or more processors to perform functions including: identifying topic information corresponding to live content, (inherent since this would be needed by the client who would request for the video information; see column 6, lines 22-24), the topic information identifying a current topic of the live content (inherent since this would be needed by the client who would request for the video information; see column 6, lines 22-24". As noted above with respect to claims 1 and 9, Teng teaches multiple scenarios whereby a client can request video programming without a processor needing to provide topic information. Further, column 6, lines 22-24 is unrelated to live content; this passage states that "A given stored video program may be played back in

accordance with a request from one or more of the clients 14-i connected to the LAN segment 13."

Claim 44 recites "One or more computer-readable media as recited in claim 43, wherein the transmitting the topic finished indication comprises transmitting, as the topic finished indication, a cancel topic indicator", while claim 45 recites "One or more computer-readable media as recited in claim 43, wherein the transmitting the topic finished indication comprises transmitting, as the topic finished indication, new current topic information", which subject matter is not taught, disclosed, suggested or motivated by Teng.

The Office Action correctly states (p. 18) that Teng "does not teach sending a cancel topic indicator or a current topic indicator as the topic finished indicator" (which is not what is recited in these claims) and then states that such "are obvious design choices". The admission that Teng is silent with respect to these affirmatively-recited aspects of claims 44 and 45 is also an admission that the rejection fails to meet the standards set forth in the MPEP for forming a *prima facie* case of unpatentability. Such aspects are not a matter of "obvious design choice" because they relate to topic information transmitted to a server to make the topic information available for searching and Teng is silent with respect to searching or transmitting information to a server to make information available for searching.

Claim 57 recites "A method comprising: identifying a set of search criteria to be compared to information describing a plurality of live presentations; transmitting the set of search criteria to a server; and receiving a list of live presentations currently in progress that match the search criteria, and further

comprising: transmitting a notification type to the server that indicates how a user that identifies the set of search criteria should be notified by the server when a live presentation is determined by the server to match the search criteria", which is not taught, disclosed, suggested or motivated by Teng.

The Office Action cites col. 7, lines 44-55 with respect to "identifying a set of search criteria to be compared to information describing a plurality of live presentations; transmitting the set of search criteria to a server; and receiving a list of live presentations currently in progress that match the search criteria", as recited in claim 57. This passage merely describes various embodiment of a directory list and is silent with respect to search criteria, identification of search criteria, transmission of such criteria to a search server, or receiving a list of live presentations currently in progress that match any search criteria (see arguments with respect to claims 1 and 9, claim 55 and claim 8).

The Office Action correctly states (p. 17) that Teng fails to teach "transmitting a notification type to the server that indicates how a user that identifies the set of search criteria should be notified by the server when a live presentation is determined by the server to match the search criteria", as recited in claim 57, and repeats that "official notice is taken" and that "It would have been obvious"

With respect to the official notice, Applicant again calls for an affidavit or other evidence to support the conclusions expressed in the Office Action in the event that such rejection is maintained. The conclusion that "It would have been obvious" has been repeatedly rebutted.

With respect to all of the unpatentability rejections, Applicant notes the requirements of MPEP §2143, entitled "Basic Requirements of a Prima Facie Case of Obviousness" (see also MPEP §706.02(j), entitled "Contents of a 35 U.S.C. 103 Rejection."). MPEP §2143 states that "To establish a prima facie case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." Inasmuch as the reference fails to teach or disclose the elements recited in the claims, the reference cannot provide motivation to modify their teachings to arrive at the invention as claimed, and the Examiner has identified no such teaching or disclosure in the reference. As a result, the first prong of the test cannot be met.

MPEP §2143 further states that "Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

Inasmuch as the reference fails to provide all of the features recited in Applicant's claims, the third prong of the test is not met. As a result, there cannot be a reasonable expectation of success. As such, the second prong of the test cannot be met.

MPEP §2143 additionally states that "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." This fourth criterion cannot be met because the reference fails to teach or disclose the elements recited in the claim.

Accordingly, the unpatentability rejections fail all of the criteria for establishing a *prima facie* case of obviousness as set forth in the MPEP.

Further, suggestion to modify as put forth in the Office Action appears to employ an improper "obvious to try" rationale, as is discussed below in more detail with reference to MPEP §2145(X)(B). This MPEP section states that:

The admonition that 'obvious to try' is not the standard under §103 has been directed mainly at two kinds of error. In some cases, what would have been 'obvious to try' would have been to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful.... In others, what was 'obvious to try' was to explore a new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it. *In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988) (citations omitted).

No guidance has been identified within the reference to determine which elements to pick or choose from the reference, or of how to couple them to somehow arrive at subject matter such as is claimed.

Moreover, with respect to all of the unpatentability rejections, no evidence has been provided as to why it would be obvious to modify the teachings of the reference. Evidence of a suggestion to combine or modify may flow (i) from the prior art reference itself, (ii) from the knowledge of one skilled in the art or (iii) from the nature of the problem to be solved. However, this range of sources does not diminish the requirement for actual evidence. Further, the showing must be clear and particular. See *In re Dembicza*k, 175 F.3d 994, 998 (Fed. Cir. 1999).

For at least these reasons, Applicant respectfully requests that the §103 rejection be withdrawn, and that Applicant's claims 8, 13, 16, 18, 19, 26, 27, 29, 30, 33-35, 43-45 and 57 be allowed.

Examination Deficiencies

Additionally, the Examiner's response to argument is deficient in multiple regards. A first deficiency is that the response to argument clearly fails to respond to Applicant's arguments with respect to the rejections under 35 U.S.C. §102, or, in the alternative, is an admission that these rejections are defective.

Applicants note the requirements of MPEP §707.07, entitled "Completeness and Clarity of Examiner's Action". This MPEP section cites 37 CFR §1.104, entitled "Nature of examination" which in turn states, in subsection (b), entitled "Completeness of examiner's action" that "The examiner's action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made."

This MPEP section further states, under a heading labeled "Examiner Note" that "The Examiner must, however, address any arguments presented by the applicant which are still relevant to any references being applied." The Office Action clearly fails to comport with these requirements as set forth in the MPEP, at least because the Office Action both fails to address Applicant's arguments with respect to anticipation and continues to reject claims as being anticipated.

A second deficiency is that even under the unpatentability rejections, the combinations fail to provide all of the features recited in any of Applicant's independent claims. The Examiner has ignored these features without providing any appropriate legal basis for doing so.

A third deficiency is the failure to respond to all arguments traversing the unpatentability rejections. Merely repeating that "it would be obvious" to provide

the features recited in the claims does not constitute a basis for rejection of the claims, particularly when the reference fails to provide the features recited in the claims and the rejections fail to meet the standards for such rejections as set forth in the MPEP and as demonstrated by Applicant.

For at least these reasons, the Office Action fails to comport with appropriate standards for examination. The Examiner should either allow Applicant's claims or provide a meaningful basis for rejection and an appropriate response to Applicant's arguments.

New Claims

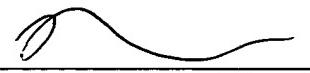
New claims 58-92 are supported at least by text appearing in the Detailed Description and by the accompanying illustrations of the application as originally filed. New claims 62-73 are analogous to claim 9 and claims dependent therefrom, but differ in scope. No new matter is added by new claims 58-92. New claims 58-92 distinguish over the art of record and are allowable.

Conclusion

Claims 1-20, 22-38 and 40-92 are in condition for allowance. Applicant respectfully requests reconsideration and issuance of the subject application. Should any matter in this case remain unresolved, the undersigned attorney respectfully requests a telephone conference with the Examiner to resolve any such outstanding matter.

Respectfully Submitted,

Date: Nov. 19, 2003

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